

## **REMARKS**

Claims 17-25 have been amended. Claims 17-45 remain pending in the application. Claim 31-45 are currently withdrawn (under traverse). Reconsideration is respectfully requested in light of the following remarks.

### **Restriction Requirement:**

Applicants maintain their traversal of the previously asserted restriction requirement. In this regard, Applicants filed a Petition pursuant to 37 C.F.R. § 1.144 on December 5, 2005.

### **Rule 131 Declaration:**

A declaration under 37 C.F.R. § 1.131 is submitted herewith. The declaration indicates that Applicant's invention was completed (reduced to practice) before December 11, 2000. Therefore, Rivera et al. (U.S. Patent Application 2002/0107699) is removed as a prior art reference since its effective date is February 8, 2001. Additionally, Andersson et al. (U.S. Patent Application 2002/0087419 A1) is also removed as a prior art reference since its effective date is December 29, 2000. Similarly, references King et al. (U.S. Patent Application 2002/0152133), Tamboli et al. (listed both as U.S. Patent 6,792,431 and U.S. Patent Application 2003/0014617), Yassin et al. (U.S. Patent 6,829,745), and Gralla (How the Internet Works, 6<sup>th</sup> Ed.) are also removed as prior art references, as their effective dates are, respectively, March 9, 2001, May 7, 2001, June 28, 2001 and September 7, 2001.

### **Section 101 Rejection:**

The Examiner rejected claims 17-25 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In light of the amendments to claims 17-25, withdrawal of this rejection is respectfully requested.

**Section 112, Second Paragraph, Rejection:**

The Examiner rejected claims 17-26 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants respectfully traverse this rejection for at least the reasons presented above.

Regarding claim 17, the Examiner contends that the phrase, “configured to maintain data persistence of files stored in a database” is “indefinite because it is not known if the database includes “corresponding files, in-bound and outbound documents, and/or other files.” However, claim 17 clearly states “wherein said files stored in said database correspond to said XML content in said in-bound documents and said out-bound documents respectively.” Thus, claim 17 is clearly not indefinite. Applicants respectfully request removal of the § 112 rejection of claim 17.

Regarding claim 18, the Examiner asserts that “it is not known if the ‘comprising’ is ‘in replacement of’ or ‘in addition to’ the previous method steps.” The Examiner further “adapts the presumption that the term ‘wherein’ connotes a different meaning than the term ‘further comprising’”, citing *CAE Screenplates Inc. v. Heinrich Fielder GmbH & Co. KG*, 224 F.3d 1308, 1317, 55 USPQ2d 1804, 1810 (Fed. Cir. 2000).

Specifically, the Examiner contends that since claim 18 recites “comprises” rather than “further comprises” as others if applicants’ claims recite, the term “comprises” somehow means, “in replacement of”. The Examiner’s interpretation is incorrect. The use of the term “comprising” is well understood and well established. As stated quite clearly at M.P.E.P. 2111.03, “[t]he transitional term ‘comprising’, which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” The term “comprising” has never been interpreted as meaning “in replacement of”, as suggested by the Examiner. It has been established in patent practice that the terms “comprise” or “contain” are not exclusive of other materials in contrast with “consisting of” or “composed of.” *Ex parte*

*Glycofrides*, 63 USPQ 242, 243 (Pat. Off. Bd. App. 1944). “Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim. *Genentech, Inc. v. Chiron Corp.*, 42 USPQ 2d 1608, 1613 (Fed. Cir. 1997). The term “further” is completely superfluous in Applicants’ claims. The inclusion or omission of the term “further” does not change the well-settled meaning of the term “comprising”.

Additionally, the case cited by the Examiner, namely *CAE Screenplates Inc. v. Heinrich Fielder GmbH & Co.*, involved the terms “bottom” and “bottom plate” that were elements of the relevant invention. The cited case does not involve the transitional terms “comprising” and “further comprising”, as is the case here. There is nothing in the cited case that would suggest that the term “comprising” might be interpreted as meaning “in replacement of”, as suggested by the Examiner. Also, the fact that the superfluous term “further” is recited in other claims, does not change the fact that “[t]he word “comprising” alone [is] synonymous with “including”. *Ex parte Davis*, 80 USPQ 448, 449 (Pat. Off. Bd. App. 1948). Also, by depending from claim 17, claim 18 clearly, and by definition, includes all the limitations of claim 17.

However, to avoid additional unnecessary delays in the prosecution of this case, Applicants have amended claim 18 to recite, “further comprising”. Applicants strongly assert that this does not result in any change to the claimed subject matter or scope of claim 18. As such, Applicants respectfully request removal of the § 112 rejection of claim 18.

Regarding claim 26, the Examiner contends that the phrase, “appropriate suitable content for an underlying markup language” is unclear and makes claim 26 indefinite. Applicants respectfully disagree. Claim 26 recites, in part, “transforming said retrieved XML content into appropriate content suitable for an underlying markup language of an Internet browser used by said purchasing professional”. When the relevant section of claim 26 is read in its entirety the scope of claim 26 is readily apparent to one of ordinary skill in the art. One skilled in the art would not have any trouble understanding

transforming XML content to “appropriate content suitable fro an underlying markup language of an Internet browser.” As such, Applicants respectfully request removal of the § 112 rejection of claim 26.

**Section 103(a) Rejection:**

The Examiner rejected claims 17-22 and 24-30 under 35 U.S.C. § 103(a) as being unpatentable over Rivera et al. (U.S. Publication 2002/0107699) (hereinafter “Rivera”) in view of Bowker et al. (U.S. Patent 6,601,071) (hereinafter “Bowker”), and claim 23 as being unpatentable over Rivera and Bowker in view of Andersson (U.S. Publication 2002/0087419). Applicants respectfully traverse this rejection for at least the reasons below.

As noted above, a declaration under 37 C.F.R. § 1.131 is submitted herewith. The declaration indicates that Applicant’s invention was reduced to practice before December 11, 2000. Therefore, Rivera et al. (U.S. Patent Application 2002/0107699) and Andersson are removed as prior art references since their effective dates are February 8, 2001 and December 29, 2000, respectively. As such, Applicants respectfully request removal of the § 103(a) rejection of claims 17-30.

In regard to the Examiner’s comments regarding lexicography and definitions of certain terms, Applicants make no admissions. Furthermore, Applicants note that such considerations are questions of fact and must be determined based on the evidence of record.

## CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-90700/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☒ Other: Exhibits 1, 2 and 3
- ☒ Other: Executed Declarations under 37 C.F.R. § 1.131 of Invention of Sridatta Viswanath and Yafeng Li

Respectfully submitted,



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